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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,439	06/26/2001	Mark Landesmann	084561-0108	9934

22428 7590 11/29/2004

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/888,439

Applicant(s)

LANDESMANN, MARK

Examiner

Khanh H. Le

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*ML*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1, 10-13, 47-49, 51-52, 64-65, 68, 94, 100-103, 137-139, 141-142, 154-155, 158, 204, 206, 207-357 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 239-245, 247-249, 251, 291-297, 299-301, 303, 340-346, 348-35, 352 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                     | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This Office Action is responsive to the Amendments dated June 14, 2004.

2. **Previous claims status:** Pending claims were 1, 10-13, 47-49, 51-52, 64-65, 68, 94, 100-103, 137-139, 141-142, 154-155, 158, 204, 206.

The independent claims were 1, 94, 204, and 206 with 94 and 204 paralleling claim 1 in system and program formats. The dependent claims were 10-13, 47-49, 51-52, 64-65, 68, with corresponding claims 100-103, 137-139, 141-142, 154-155, 158.

**Present claims status:** Claims 1, 94, 204 are currently amended. New claims 207-357 are added.

Of the new claims 207, 259, and 308 are independent. Method claim 207 is independent with 208-258 as dependents. Independent claims 259 and 308 parallel independent claim 207, in computer program product and system formats respectively, with their dependent claims 260-307 and 309-356 paralleling claims 208-255 respectively.

Thus presently presented are claims 1, 10-13, 47-49, 51-52, 64-65, 68, 94, 100-103, 137-139, 141-142, 154-155, 158, 204, 206, 207-357 with claims 1, 94, 204, 206, 207, 259, and 308 as independent.

### **Restriction**

3. **37 CFR 1.142 (Requirement for restriction) states:**

If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action

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being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

**4. Distinct inventions and Election by original presentation:**

**Claims 249, 301 and 350 are subject to a restriction:**

Newly submitted independent claims 249, 301 and 350 are directed to an invention that is independent and distinct from the invention originally claimed for the following reasons: it is directed to an invention relating to offering incentive based on a buyer providing ratings for interactive TV programs which is totally different from the main invention of providing incentives based on independently verifiable purchase records. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims are 249, 301 and 350 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Claims are 249, 301 and 350 are also restricted as being distinct inventions of the main invention for the reasons stated above.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

**5. Restriction requirement. Species.**

This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Group I: All pending claims, except 249, 301 and 350 and not listed in Groups II-IV below, drawn to methods, system and/or apparatus for receiving from buyers third party proof of records, entering such information into an e-database, and providing incentives to such buyers, classifiable in class/subclass 705/14.

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II. Group II: Claims 239- 245, and parallel claims 291-297, and 340-346 related to an interactive TV application, classified in class/subclass 348/61 or 348/552.

III. Group III: 251 and parallel claims 303, and 352 weighting or scoring questions for presentation to users, classifiable in class 705/7 and/or 10.

IV. Claims 247-248 and parallel claims 299-300, and 348-349 drawn to rating of products, weighting of ratings, classifiable in class/subclass 705/10.

6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. The inventions I and II are distinct, each from the other because:

(1) the genus (invention I) as claimed does not require the particulars of the species as claimed for patentability, and (2) that the species (Invention II) has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the inventions of Group I as claimed does not require the particulars of the species II as claimed because distribution of incentives via an interactive television or receiving interactive television viewing habits of buyer and rating TV programs

are the particulars of the species which is not required in the combination invention of Group I for patentability .

Further, the Group II species features , such as cited above, have separate utility by themselves or in other combinations because all these features related to an interactive television application are extra features that are not required in the claims of Group I.

10. The inventions I and III are distinct, each from the other because:

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(1) the genus (invention I) as claimed does not require the particulars of the species as claimed for patentability, and (2) that the species (Invention III) has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the inventions of Group I as claimed does not require the particulars of the species III as claimed because weighting questions based on data associated with the questioned buyer, selecting the question based on the weight, presenting it, storing the response, making a decision based thereon are the particulars of the species which is not required in the invention of Group I for patentability .

Further, the Group III species features, such as cited above, have separate utility by themselves or in other combinations because all these features related claim 251 (main claim in Species III) are extra features that are not required in the claims of Group I.

11. The inventions I and IV are distinct, each from the other because:

(1) the genus (invention I) as claimed does not require the particulars of the species as claimed for patentability, and (2) that the species (Invention III) has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the inventions of Group I as claimed does not require the particulars of the species IV as claimed because asking a buyer to rate a product or service, when a purchase has been made, receiving and weighting the ratings, and creating an average rating ,

are the particulars of the species which is not required in the invention of Group I for patentability . Further, the Group I V species features, such as cited above, have separate utility by themselves or in other combinations because all these features related claim 248 (main claim in Species IV) are extra features that are not required in the claims of Group I.

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12. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

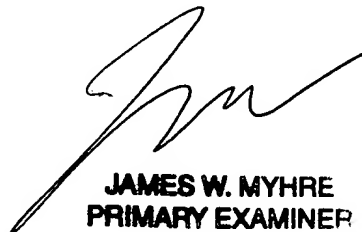
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

November 27, 2004

RHL

KHL



**JAMES W. MYHRE  
PRIMARY EXAMINER**